

P17762.A13

5.6 C.7
64. (New) The method according to claim 61, the non-standard signal including capability information of the facsimile destination.

65. (New) The method according to claim 64, the capability information includes at least resolution, print paper size, and coding system.

66. (New) A method for transmitting an electric mail communication function capability from a receiving terminal to a facsimile sender, the receiving terminal having an electric mail communication section that performs electric mail communication with a communication terminal via a computer network, the method comprising:

performing a facsimile communication with the facsimile sender via a telephone network; and

adding identification information to a non-standard signal included in a facsimile protocol transmission while the facsimile communication is performed with the facsimile sender, the identification information indicating that the communication apparatus is capable of the electronic mail communication.---

REMARKS

Upon entry of the present amendment, claims 1-6 12-15, 17-19 and 21-52 will have been canceled. In their stead, claims 53-66 will have been submitted for consideration. In view of the herein contained amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection, together with an indication of

P17762.A13

the allowability of all the claims pending in the present application, in due course. Such action is respectfully requested and is now believed to be appropriate and proper.

In the outstanding Official Action, the Examiner considered Applicants Election With Traverse filed on September 13, 2002 and indicated that the traverse was not found to be persuasive. Accordingly, the Examiner maintained the Restriction Requirement, made the same final, and withdrew claims 7-11, 16 and 20 from further consideration in the present application.

As noted above, by the present Response, Applicants have canceled the previously elected claims and have submitted new claims 53-66 for consideration herein. These claims are submitted to be drawn to the elected invention and consideration thereof is respectfully requested. Moreover, Applicants submit that because of the relationship between the various claims, all the claims pending in the present application should be examined.

Applicants note with appreciation the Examiner's acknowledgment, in the outstanding Official Action of Applicant claim for foreign priority under 35 U.S.C. § 119 and the receipt of all of the certified copies of the priority documents. Applicants further note with appreciation the Examiner's confirmation of the consideration of the references listed in the various Information Disclosure Statements filed in the present application and the return of the signed and initialed PTO-1449 Forms.

P17762.A13

In the outstanding Official Action, the Examiner rejected claims 1-6, 12-15, 17-19 and 21-52 under 35 U.S.C. § 102(e) as being anticipated by HOUGHTON et al. (U.S. Patent No. 6,009,153). Applicants respectfully traverse the above rejection and submit that it is inappropriate with respect to the combination of features recited in each of Applicants currently pending claims.

As disclosed in the present application, the present invention relates to, for example, an Internet facsimile machine which includes a capability for transmitting data over the Internet as well as for transmitting data via facsimile. Thus, when a receiving apparatus can receive data over the Internet, it should be transmitted over the Internet while in the case where the receiver cannot receive data over the Internet, the telephone network should be used. However, according to the features of conventional machines, data communication cannot be carried out in such an efficient manner, since such operation requires that the electronic mail capability of the receiver is transmitted back to the transmitting Internet facsimile apparatus. Thus, the transmitting apparatus cannot determine whether or not the receiving apparatus can receive electronic data over the Internet or whether the data must be transmitted by facsimile.

However, according to the features of the present invention as recited in presently pending claim 53, the communication apparatus includes a facsimile communicator that performs facsimile communication via a telephone network, and an electronic mail

P17762.A13

communicator that performs electronic mail communication by a computer network. Further, the communication apparatus includes a detector that detects identification information included in a non-standard signal which is transmitted from the destination while the facsimile protocol transmission is being performed. The identification information indicates whether or not the facsimile destination is capable of receiving electronic mail communications. Further, as recited in, for example, claim 53, when the identification information (indicating that the facsimile destination is capable of electronic mail communication is detected), the controller disconnects the facsimile communication and performs communication via the computer network (i.e., Internet).

It is respectfully submitted that the combination of features recited in, e.g., Applicants claim 53, is not taught, disclosed nor rendered obvious by the HOUGHTON et al. reference cited by the Examiner. Accordingly, the claims pending in the present application are submitted to be patentable thereover and an indication to such effect is respectfully requested in due course.

HOUGHTON et al. relates to a technique for programming operating parameters in an electronic device such as a programmable configuration setting. The HOUGHTON et al. device utilizes an interactive response configuration server which is accessible through the telephone network. The server provides various voice prompts to an electronic device operating via a telephone connection. The voice prompts relate to a preferred manner of

P17762.A13

operation achievable by the use of particular parameter settings. The operating parameter settings are determined based upon the operator's responses to the voice prompts. A programming signal, including representations of the desired parameter settings, is generated and transmitted to the electronic device which then sets the values of its programming operating parameters in accordance with the received operating signal.

However, HOUGHTON et al. does not disclose at least utilization of a non-standard signal to convey identification information that indicates whether a particular facsimile destination (from which the non-standard signal is transmitted) is capable of an electronic mail communication. At least for this reason, it is respectfully submitted that each of Applicants claims are clearly patentable over HOUGHTON et al.

Additionally, and independently of the above, Applicants note that HOUGHTON et al. utilizes a configuration server which is dialed by the facsimile machine. The configuration server is an interactive response system that provides voice prompts over the telephone system to the operator regarding desired operating parameters and/or desired manners of operation of the facsimile machine. Applicants' invention does not require the use of a server and is thus substantially simpler, more efficient and less costly.

Additionally, Applicants note that the configuration server is provided for programming the facsimile machine. Applicants invention does not program a facsimile

P17762.A13

machine but merely detects a signal including identification information regarding the capabilities of a particular destination facsimile apparatus.

Accordingly, for each of these reasons and certainly for all of these reasons, it is respectfully submitted that the claims in the present application are clearly patentable over HOUGHTON et al. An action to such effect is respectfully requested in due course.

According to a further feature of the present invention, the communication apparatus recited in, e.g., claim 59, includes, inter alia, an obtainer that obtains an electronic mail address of a facsimile destination. The electronic mail address of the facsimile destination can be included in a non-standard signal which is transmitted from the facsimile destination while the facsimile communicator performs a facsimile protocol transmission. It is respectfully submitted that at least this feature of Applicants claimed invention, in the claimed combination, is not taught, disclosed nor rendered obvious by HOUGHTON et al.

As a further feature of Applicants' invention, as reflected in claim 60, the communication apparatus serves as an answering (receiving) apparatus and includes, inter alia, an adder that adds identification information to the non-standard signal which the facsimile communicator transmits to the facsimile sender during a facsimile protocol communication. The identification information indicates that the communication apparatus is capable of the electronic mail communication. The combination of features recited in claim 60 is also not disclosed or rendered obvious by HOUGHTON et al.

P17762.A13

Method claims 61 and 66 define methods for identifying a destination terminal and transmitting an electronic mail communication function from a receiving terminal. It is respectfully submitted that the methods as recited in claims 61 and 66 are not taught, disclosed nor rendered obvious by HOUGHTON et al.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all the claims pending in the present application, in due course. Such action is respectfully requested and is now believed to be appropriate and proper.


SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have discussed the disclosure of the reference relied upon by the Examiner and have pointed out the deficiencies thereof. Applicants have discussed the features of Applicants claims and with respect to such features have pointed out the shortcomings of the reference with respect thereto. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully request an indication to such effect in due course.

P17762.A13

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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